

## **1. REMARKS / DISCUSSION OF ISSUES**

Claims 21-36 are pending in the application. Because no amendments are made to the claims, a listing under Rule 121 is not required.

### **Rejections under 35 U.S.C. § 103**

1. Claims 21-27 and 29-35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Mendez, et al.* (US PAP 2004/0139178) and *Cochran, et al.* (US PAP 2002/0161867).
2. Claims 28 and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Mendez, et al.* and *Cochran, et al.* and *Wendt, et al.* (US Patent 6,067,558).

For at least the reasons set forth herein, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and that all claims are patentable over the applied art.

As stated in MPEP § 2143, in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

It is established that rejections on obviousness grounds cannot be sustained by mere conclusory statements: instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. (*KSR Int'l v. Teleflex*, 127 S. Ct. at 1741). However, the Court in *KSR* continued: "A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. See *Graham*, 383 U.S., at 36, 86 S. Ct. 684, 15 L. Ed. 2d 545 (warning against a "temptation to read into the prior art the teachings of the

invention in issue" and instructing courts to "'guard against slipping into the use of hindsight'" (quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F.2d 406, 412 (CA6 1964)))." Moreover, if there is no suggestion to combine the teachings of the applied art, other than the use of Applicants' invention as a template for its own reconstruction, a rejection for obviousness is improper. *Ex parte Crawford, et al.* Appeal 20062429, May 30, 2007.

i. Claims 21 and 29

Claim 21 is directed to a system for configuring a network device coupled to a local network. The system features, inter alia:

*"a configuration server coupled to the network, the configuration server generating a web page that enables access to a configuration applet;  
...the configuration applet when executing on the node searches the local network for the network device..."*

Claim 29 includes similar features.

Plainly, the configuration searches the local network for the network device.

The Office Action relies on the disclosure of paragraph [0044] of *Mendez, et al.* and paragraph [0043] of *Cochran, et al.* for the alleged disclosure of at least these features of claims 21 and 29. (See page 3 of the Office Action). Moreover, the Office Action concedes that *Mendez, et al.* is silent on the configuration applet and its searching as set forth in claims 21 and 29, and turns to *Cochran, et al.* for the alleged disclosure thereof. (See pages 5 and 6 of the Office Action.) Applicants respectfully disagree.

*Cochran, et al.* describes a device configuration assembly 12 in paragraph [0042] Fig. 3 shows a user interface including a device list 134 and an address search option 13. In operation, the device configuration assembly 12 may automatically detect communication interfaces (e.g., network cards) disposed in the computing device 14. Moreover, the reference discloses that the address search option 138 of the user interface provides a variety of network information for the detected communications interfaces via a table 146. Paragraph [0043] describes table 146 of Fig. 3. However, there is no

disclosure of searching for other than network interfaces. Therefore, assuming *arguendo* that it was proper to combine *Mendez, et al.* and *Cochran, et al.*, there is at least one feature not disclosed in the applied art. Thus, a *prima facie* case of obviousness has not been established at least because the applied art fails to disclose all features of claims 21 and 29.

In addition, there is no disclosure or suggestion of a configuration applet, or the suggestion to supplant the applet of *Mendez, et al.* in *Cochran, et al.* Moreover, there is no disclosure or suggestion in *Mendez, et al.* that the applet's searching the network for devices when executing on a node. As such, Applicants respectfully submit that the Examiner has cobbled a rejection with incomplete teachings of the applied art using Applicants' claims as templates for their own replication. This is wholly improper in the determination of patentability.

Furthermore, Applicants submit that the Examiner's basis for combining the rejections fails to articulate reasoning with some rational underpinning to support the legal conclusion of obviousness. To this end, the Examiner states:

One of ordinary skill in the art at the time of applicant's invention would have clearly recognized that it is quite advantageous for the system of *Mendez* to be able to search the local network for the network device in order to allow a user to determine whether the devices exists on the local network by searching the desired devices before configuring the network device. It is for this reason that one of ordinary skill in the art would have been motivated to implement system of searching the local network before configuring the network device.

Respectfully, because there is no need set forth in *Mendez, et al.* to search for devices as the Examiner suggests; and no disclosure in *Cochran, et al.* for such a search of devices. Moreover, there is no basis proffered in the Office Action to support the alleged need of *Mendez, et al.* and benefit thereto. Thus, while some reasoning is articulated, the rational underpinning required to do so is neither provided in the references nor otherwise properly supported.

Thus, not only do the combined references fail to disclose at least one feature of each of claims 21 and 29, but also the references are not properly combined.

For at least the reasons set forth above, Applicants submit that a prima facie case of obviousness has not been established; and claims 21 and 29 are patentable. Claims 22-28 and 31-36, which depend from claims 21 and 29, are patentable for at least the same reasons.

### **Conclusion**

In view the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:  
Agilent Technologies, Inc.

/s/William S. Francos/

by: William S. Francos (Reg. No. 38,456)

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